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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/619,748	07/15/2003	Andreas Mau	09282.0048-00	7407		
22852	7590	06/11/2010	EXAMINER			
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ART UNIT		PAPER NUMBER				
3693						
MAIL DATE		DELIVERY MODE				
06/11/2010		PAPER				

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREAS MAU

Appeal 2009-006002
Application 10/619,748
Technology Center 3600

Decided: June 11, 2010

Before HUBERT C. LORIN, TONI R. SCHEINER, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Andreas Mau (Appellant) seek our review under 35 U.S.C. § 134 of the final rejection of claims 31-58. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

This invention is a method for managing employee benefits in real-time and includes requesting and receiving bid for services from a benefits provider. *See Specification 2:2-12.*

Claim 31, reproduced below, is illustrative of the subject matter on appeal.

31. A computer-implemented method for providing a distributed service marketplace, the method comprising:
 - receiving, from a user, requirements for services;
 - electronically preparing a search message including the requirements for services;
 - transmitting the search message to one or more service providers;
 - automatically receiving bids from the one or more service providers that satisfy the requirements for services;

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed Sep. 27, 2007) and Reply Brief ("Reply Br.," filed Apr. 10, 2008), and the Examiner's Answer ("Answer," mailed Apr. 28, 2008).

sorting the received bids based on criteria selected by the user;

automatically selecting a best bid from the received bids based on the sorting;

automatically transmitting a contract document to the service provider associated with the best bid; and

automatically receiving the contract document from the service provider associated with the best bid, wherein the contract document includes a status of at least one of accepted, rejected, and amended.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Proudler	US 2002/0023212 A1	Feb. 21, 2002
Moderegger	US 2002/0049642 A1	Apr. 25, 2002
Thompson	US 2003/0229522 A1	Dec. 11, 2003

E-Benefits, Inc., <http://www.ebenefitsinc.com/>. (last visited Dec. 22, 1997). [Hereinafter, E-Benefits.]

MacSweeny, Gregory, “Billing System Drives Cross-Sell Efforts,” Insurance & Technology, June 2003, Vol. 28, Issue 6, p. 23. [Hereinafter, MacSweeny.]

Singerman, Frederic S., “The Impact of the Electronic Signatures Act on Plan Administration,” Journal of Pension Benefits: Issues in Administration, Autumn 2000, Vol. 8, Issue 1, pp. 3-8. [Hereinafter, Singerman.]

Tomsen, Mai-lan, “Killer Content: Strategies for Web Content and E-Commerce,” Addison Wesley Longman, Inc., Reading, Massachusetts, April 2000, pp. 13, 129-133, and 177-180. [Hereinafter, Tomsen.]

The following rejections are before us for review:

1. Claims 31, 32, 39, and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over E-Benefits and Moderegger.
2. Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over E-Benefits, Moderegger, and Proudler.
3. Claims 34-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over E-Benefits, Moderegger, and MacSweeny.
4. Claims 37 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over E-Benefits, Moderegger, MacSweeny, and Singerman.
5. Claims 40-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over E-Benefits, Moderegger, and Thompson.
6. Claim 43 is rejected under 35 U.S.C. §103(a) as being unpatentable over E-Benefits, Moderegger, and Tomsen.
7. Claims 44-58 are rejected for substantially the same reasons as provided for claims 31-43.

ISSUES

The first issue is whether claim 31 is unpatentable under 35 U.S.C. § 103(a) over E-Benefits and Moderegger. Specifically, the issue is whether an accepted status in the contract document is non-functional descriptive material and therefore, patentable weight need not be given to descriptive material. The rejections of claims 32, 34-45, and 47-56 under 35 U.S.C. § 103(a), also turn on this issue.

The second issue is whether claim 33 is unpatentable under 35 U.S.C. § 103(a) over E-Benefits, Moderegger, and Proudler. Specifically, the issue is whether Proudler teaches a step of automatically selecting a next best bid from the received bids based on the sorting if the received contract document includes a status of rejected. The rejection of claim 46 under 35 U.S.C. § 103(a) also turns on this issue.

The third issue is whether claims 57 and 58 are unpatentable under 35 U.S.C. § 103(a). Specifically, the issue is whether Moderegger describes a computer that is capable of automatically receiving a contract document that includes a status of accepted, rejected, or amended.

FINDINGS OF FACT

We find that the following findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

We adopt the Examiner's finding of fact related to Moderegger and Proudler. Answer 5-17.

ANALYSIS

The rejection of method claims 31-32, 39, and 42 under §103(a) as unpatentable over E-Benefits and Moderegger.

The Appellant argues claims 31, 32, 39, and 42 as a group. App. Br. 14-16. We select claim 31 as the representative claim for this group, and the remaining claims 32, 39, and 42, stand or fall with claim 31. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The method of claim 31 includes a step of “automatically receiving the contract document . . . , wherein the contract document includes a status of at least one of accepted, rejected, and amended.” The Appellant and the Examiner dispute whether the description of transmitting an award decision informing a bidder that they have been awarded a contract in paragraph [0056] of Moderegger teaches the claimed contract document *that includes the status of accepted*. *See* App. Br. 14-16, Reply Br. 2-3 and Answer 17-18.

However, to the extent that the Appellant argues that Moderegger’s description of receiving an award decision, which includes information containing an award of contract, is not the same as the claimed step of receiving a contract document because it does not include a status of accepted, the distinction is a matter of the content of the information, that is, descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowery*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994). *See also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004).

The claimed “status of accepted” is clearly information, albeit the information is characterized as being a status of accepted. The Appellant has not come forward with evidence sufficient to show that the structure of the information, *i.e.*, the data, is functionally affected by it being a status of accepted, rejected, or amended in claim 31. Absent such evidence, it was reasonable to conclude that the “status of accepted” aspect of the information was descriptive and not functionally related to any structure of the invention in claim 31 and as such fell under the category of patentably

inconsequential subject matter. The fact that claim 31 requires the contract document to include a status of accepted does not change the fact that the contract document is associated with data but that aspect of the data which is to be a status of accepted is properly considered to be nonfunctional and descriptive. *See Ex parte Curry*, 84 USPQ2d 1272, 1275 (BPAI 2005) (informative)

Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (*i.e.*, the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.)

See also Ex parte Mathias, 84 USPQ2d 1276, 1279-1280 (BPAI 2005) (informative).

Accordingly, we find that the Appellant has not overcome the rejection of claim 31, and claims 32, 39, and 42, dependent thereon, under §103(a) as unpatentable over E-Benefits and Moderegger.

The rejection of method claim 33 under 35 U.S.C. § 103(a) as unpatentable over E-Benefits, Moderegger, and Proudler.

Claim 33 depends from claim 31 and further recites that “if the received contract document includes the status of rejected, then automatically *selecting a next best bid from the received bids based on the sorting* and automatically repeating the automatically transmitting and automatically receiving . . .” (emphasis added.) The Appellant argues that though the cited portions of Proudler teach rejecting a contract, Proudler does not teach automatically selecting the next best bid from the received bids if the contract document includes the status of rejected. App. Br. 16-17 and Reply Br. 3-4. The Appellant asserts that Proudler is “completely silent with respect to the situation where the contract offer is rejected” and does not teach that if the contract is rejected an iterative process is performed.

Reply Br. 4. The Examiner responds that

Proudler: [077] teaches accepting or rejecting a contract that meets the criteria of the requestor. If the contract is rejected, an iterative process is performed which amends the details of the contract so as to arrive at an acceptable agreement. The Examiner considers this second contract to be a type of “next best bid”, which is subsequently selected as the contract.

Answer 19. The Appellant then asserts that Proudler is “completely silent with respect to the situation where the contract offer is rejected” and does not teach that if the contract is rejected an iterative process is performed.

Reply Br. 4.

While we find that Proudler is not silent as to what occurs when a contract is rejected, Proudler does not teach that the selection is of a next best bid *from the received bids based on the sorting*. Proudler [0077]. Paragraph [0077] of Proudler does describe a negotiation process that occurs after a bid is rejected and is iterative until a contract is agreed or an impasse is reached. However, the new offers or bids of the negotiation process are

not “from the received bids” and the selection of these bids is not “based on the sorting.” Claim 33 depends on claim 31, which recites steps of receiving bids and “sorting the received bids based on criteria selected by the user.” The bids that are received during the negotiation process in paragraph [0077] are not selected from the received bids based on the previous sorting step. They were not sorted and therefore, cannot be selected “based on the sorting.”

Accordingly, we find that the Appellant has overcome the rejection of claim 33 under 35 U.S.C. § 103(a) as unpatentable over E-Benefits, Moderegger, and Proudler.

The rejections of claims 34-38, 40, 41, and 43 under 35 U.S.C. §103(a).

Claims 34-38, 40, 41, and 43 are dependent upon independent claim 31 and rejected based on the combination of E-Benefits, Moderegger, and other references. For each of these claims, the Appellant asserts that the claims are allowable by virtue of their dependence from claim 31. App. Br. 18-20. Since the Appellant has not challenged these rejections with any reasonable specificity, these claims will stand or fall with parent claim 31. See *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987). Accordingly, since we have sustained the rejection of claim 31 above, the rejections of claims 34-38, 40, 41, and 43 are also sustained.

The Rejection of Article Claims 44, 45, and 47-56 under §103(a).

The Appellant argues claims 44, 45, and 47-56 as a group. App. Br. 20. We select claim 44 as the representative claim for this group, and the

remaining claims 45 and 47-56 stand or fall with claim 44. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

To reject claims 44-56, the Examiner relied upon the rejection of claims 31-43 (Answer 17), and likewise, to traverse the rejection of claims 44-56, the Appellant relied upon its argument in traversing the rejection of claim 31 (App. Br. 20). The Appellant argued that paragraph [0056] of Moderegger does not include a status in the contract document itself. App. Br. 14-16. For the same reasons as discussed above with regards to claim 31, we find that the Appellant has not overcome the rejection of claim 44, and claims 45, and 47-56, dependent thereon, under § 103(a).

The Rejection of Article Claim 46 under §103(a).

To reject claim 46, the Examiner relied upon the rejection of claims 31-43 (Answer 17), and again, to traverse the rejection of claim 46, the Appellant relied upon its argument in traversing the rejection of claim 33 (App. Br. 20). For the same reasons as discussed above with regards to claim 33, we find that Proudler does not teach a computer readable medium having instructions that cause a processor to automatically select a next best bid *from the received bids based on the sorting* when the received contract document includes the status of rejected. Accordingly, we find that the Appellant has overcome the rejection of claim 46 under § 103(a).

The Rejection of Apparatus Claims 57 and 58 under §103(a).

To reject independent claims 57 and 58, the Examiner relied upon the rejection of claims 31-43 (Answer 17), and likewise, to traverse the rejection of claims 57 and 58, the Appellant relied upon its argument in traversing the

rejection of claim 31 (App. Br. 20). The Appellant argued that paragraph [0056] of Moderegger does not include a status in the contract document itself. App. Br. 14-16.

However, unlike claim 31, claims 57 and 58 both recite an apparatus instead of a method. Claim 57 recites “at least one computer configured to: ... automatically receive the contract document . . . wherein the contract document includes a status of at least one of accepted, rejected, and amended.” Similarly, claim 58 recites “the ERP being configured to: ... automatically receive the contract document . . . wherein the contract document includes a status of at least one of accepted, rejected, and amended.”

These recitations of receiving a contract document that includes a status of accepted are functional recitations. *Cf. In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (functional language does not confer patentability if prior art structure has capability of functioning in the same manner). These recitations are drawn to the configuration of the structure of the computer or ERP and require the structure to have a configuration that is capable of receiving the recited contract document. Therefore, the issue is not whether Moderegger describes the function of receiving a contract document that includes the status of accepted. The issue is whether the computer of Moderegger has a structure that is configured to be capable of performing this function. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. See *In re Casey*, 370 F.2d 576, 580 (CCPA 1967). The Appellant did not raise this issue, but instead argued that the contract, itself, in Moderegger does not include a status of accepted. See App. Br. 14-16 and Reply Br. 2-3.

Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. . . Thus, the Board will generally not reach the merits of any issues not contested by an appellant.

In re Frye, 94 USPQ2d 1072, 1075 (BPAI 2010)(precedential).

Accordingly, we find that the Appellant has not overcome the rejection of claims 57 and 58 under 35 U.S.C. § 103(a) as being unpatentable.

NEW GROUND OF REJECTION

Pursuant to 37 CFR 41.50(b), we enter a new ground of rejection on claims 44-56. We reject claims 44-56 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 44 as representative, claim 44 recites “[a] computer-readable medium.” We note that the Specification is silent as the meaning of “computer-readable medium.” Giving claim 44 the broadest reasonable construction, we find that claim 44 encompasses forms of the computer program code being embodied on transitory propagating signals *per se*.² A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. §101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

² See *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

CONCLUSIONS OF LAW

We conclude that the Appellant has not overcome the rejection of:

- claims 31, 32, 39, and 42 under 35 U.S.C. §103(a) as unpatentable over E-Benefits and Moderegger;
- claims 34-36 under 35 U.S.C. §103(a) as unpatentable over E-Benefits, Moderegger, and MacSweeny;
- claims 37 and 38 under 35 U.S.C. §103(a) as unpatentable over E-Benefits, Moderegger, MacSweeny, and Singerman;
- claims 40-41 under 35 U.S.C. §103(a) as unpatentable over E-Benefits, Moderegger, and Thompson;
- claim 43 under 35 U.S.C. §103(a) as unpatentable over E-Benefits, Moderegger, and Tomsen; and
- claims 44-58 for substantially the same reasons as provided for claims 31-43.

We conclude that the Appellant has overcome the rejection of:

- claim 33 under 35 U.S.C. §103(a) as unpatentable over E-Benefits, Moderegger, and Prouder; and
- claim 46 for substantially the same reasons as provided for claim 33.

We enter a new ground of rejection on claims 44-56 under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 31, 32, 33-45, and 47-58 is affirmed.

The decision of the Examiner to reject claims 33 and 46 is reversed.

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Application 10/619,748

We enter a new ground of rejection for claims 44-56.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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